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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,722	03/30/2004	Stephen M. Andrews	PP/1-22158/P2/CGC 2053/DI	1441

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CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
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EXAMINER	
YOON, TAE H	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/812,722	ANDREWS ET AL.	
	Examiner	Art Unit	
	Tae H. Yoon	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1,3-10 and 19-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1,3-10 and 19-26 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 6, 9, 10, and 19-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,797,751. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant formulae (II) and (III) are optional UV absorbers and because the instant G_1 and G_1' are independently hydrogen or halogen encompassing G_1 and G_1' of said patent.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "hydrogen for G_2 in claim 3 lacks an antecedent basis in the formula (I) of claim 1 wherein no hydrogen for G_2 is recited.

The recited "m is 0, 1, 2, or 3" in claim 4 lacks an antecedent basis in the formula (IIA) wherein no m is recited.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 4, 7, 19-23, 25 and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Winter et al (US 5,280,124).

Winter et al teach the instant hydroxyphenyl benzotriazoles at col. 2, formula A, B and C and in examples 30 and 32. Various polymers, different applications of said

benzotriazoles and additional UV absorbers such as benzotriazoles or hydroxyaryl-s-triazines are taught at col. 8, lines 5-68.

The instant invention further recites a method of protecting contents against UV radiation by storing the contents in a clear or lightly colored rigid plastic container over Winter et al. However, Winter et al teach manufacturing of shaped articles from organic polymers containing hydroxyphenyl benzotriazoles at col. 12, lines 24-37 and said shaped articles encompass a container. Thus, storage of contents in said shaped article and protecting said content from UV radiation would be an inherent practice. Various amorphous and low crystalline polymers such as polystyrene, polycarbonate or polyester yielding clear thin sheet are also taught at cols. 10 and 11.

Thus, the invention lacks novelty.

Claims 1, 3, 19-23, 25 and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Birbaum et al (US 5,597,854).

Birbaum et al teach latent light stabilizers of triazines at col. 2. The instant triazine of claim 20 is taught at col. 53, lines 19-20. The stabilization various polymers and other additives are taught at cols. 20-29. Polyethylene and polypropylene (col. 20, lines 23-34), and polyethylene terephthalate (col. 22, line 50) are taught. Birbaum et al also teach employing various hydroxyphenyl benzotriazole at col. 26, lines 29-54. Birbaum et al also teach shaped articles and coated articles such as containers at col. 31, lines 41-63.

Thus, storage of contents in said shaped article and protecting said content from UV radiation would be an inherent practice. Thus, the invention lacks novelty.

Claims 1, 3, 4, 7, 19-23, 25 and 26 are rejected under 35 U.S.C. 103(a) as obvious over Winter et al (US 5,280,124) in view of Birbaum et al (US 5,597,854).

Birbaum et al teach shaped articles and coating of articles at col. 31, lines 46-63.

It would have been obvious to one skilled in the art at the time of invention to make plastic containers such as 2L polyester (PET, col. 11, lines 16-17) clear bottle for soft drinks or 6 oz. bottle for liquid soaps found in Supermarkets utilizing organic polymers containing hydroxyphenyl benzotriazoles and optional UV absorbers in Winter et al since Winter et al teach shaped articles which encompass bottles and since the use of clear or lightly colored plastic container having UV stabilizers is a routine practice in the art. Winter et al teach coated articles having stabilized polymeric film thereon in examples 30 and 32, and thus coating of any articles such as container would be a prima facie obviousness as evidenced by Birbaum et al.

Claims 1, 3, 21-23, 25 and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rody et al (US 4,127,586) or Dexter et al (US 4,315,848).

Rody et al teach polymeric films containing the instant hydroxyphenyl benzotriazole at col. 7, lines 1-14 and in examples. Rody et al also teach manufacturing

of shaped articles from organic polymers containing hydroxyphenyl benzotriazoles at col. 6, lines 49-65. Optional UV absorbers, stabilizers and additives are taught at cols. 7 and 8.

Dexter et al teach the same in examples and at col. 5, lines 50-61 and col. 6, lines 32-59.

Thus, storage of contents in said shaped article and protecting said content from UV radiation would be an inherent practice.

Thus, the invention lacks novelty.

Claims 1, 3, 19, 21-23, 25 and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Avar et al (US 4,891,396).

Avar et al teach the instant hydroxyphenyl benzotriazoles in abstract and its use in polymeric system such as containers or bottles in abstract and at col. 2, lines 57-64. Thus, storage of contents in said containers or bottles and protecting said content from UV radiation would be an inherent practice. Various amorphous and low crystalline polymers such as polystyrene, polyvinyl chloride or polycarbonate yielding clear thin sheet are also taught at col. 2. lines 42-56. Avar et al also teach employing other benzotriazole or aryl-s-triazine at col. 3, lines 5-45.

Thus, the instant invention lacks novelty.

Claims 1, 3-5, 7, 19-23, 25 and 26 are rejected under 35 U.S.C. 103(a) as obvious over Avar et al (US 4,891,396) in view of Winter et al (US 5,280,124), or further in view of Birbaum et al (US 5,597,854).

The instant invention further recites other hydroxyphenyl benzotriazoles over Avar et al who teach employing other benzotriazole or aryl-s-triazine at col. 3, lines 5-45. However, the instant hydroxyphenyl benzotriazoles are the art well known stabilizers for polymers as taught by Winter et al. Birbaum et al teach shaped articles and coating of articles at col. 31, lines 46-63.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the art well known hydroxyphenyl benzotriazole stabilizers of Winter et al in Avar et al since Avar et al teaches employing various benzotriazoles and since the instant hydroxyphenyl benzotriazole stabilizers are well known in the art, and coating of articles with a stabilized coating composition is also well known in the art as taught by Birbaum et al.

Claims 1, 3-5, 7, 19-23, 25 and 26 are rejected under 35 U.S.C. 103(a) as obvious over Birbaum et al (US 5,597,854) in view of Winter et al (US 5,280,124).

The instant invention further recites other hydroxyphenyl benzotriazoles over Birbaum et al who teach employing other benzotriazole. However, the instant hydroxyphenyl benzotriazoles are the art well known stabilizers for polymers as taught by and Winter et al.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the art well known hydroxyphenyl benzotriazole stabilizers of Winter et al in Birbaum et al since Birbaum et al teaches employing various benzotriazoles and since the instant hydroxyphenyl benzotriazole stabilizers are well known in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tae H Yoon
Primary Examiner
Art Unit 1714

THY/December 5, 2006